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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,319	11/22/1999	MICHAEL ADRIAN GOOCH	11129/2	3669

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EXAMINER

KAZIMI, HANI M

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,319

Applicant(s)

GOOCH, MICHAEL ADRIAN

Examiner

Hani Kazimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This application has been reviewed. Original claims 1-18 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent May not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

4. Claims 1-9, and 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popolo, U.S. patent 5,715,402.

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Claims 1-9, and 11-18, Popolo discloses a method and system for trading an instrument by providing a customer request (e.g., 112, 118-122) (column 5, line 25 et seq) to plural users (e.g., 210) (Figure 8), receiving at least one response (220) via a communication network (Figure 2), determining a best price and providing first and second indications to winners and losers (144) (Figure 6; column 11, line 25 et seq), first computer (12), at least one second/third computer for user response (22-28) (Figure 2), and a second computer (e.g., 32, 34) transmitting a customer request to the first computer (12).

Popolo also discloses eliminating a response (e.g., by rejection) (column 12, line 10 et seq), request data (column 5, line 40 et seq), predetermined condition (e.g., subattribute (176)), itemization (column 8, line 60 et seq), initiating settlement (column 12, line 10 et seq), eliminating the request (column 9, line 17 et seq; column 9, line 60 et seq), amending the request (column 11, line 20 et seq), predetermined signal (column 14, line 50 et seq), pricing data (190), private fax/e-mail communication (column 12, line 15 et seq), subrequest (i.e., bid dates; column 9, line 65 et seq; also column 4, line 5 et seq), generating a predetermined group (e.g., those who bid successfully/ unsuccessfully).

Popolo fails to teach that the first indication indicating that the response is the best price response, and the second indication indicating that the response is not the best price response.

Since Popolo teaches that "the system automatically notifies the buyer of the acceptance or rejection by electronic mail, as indicated at block 146. The acceptance or rejection message will appear as new mail in the Electronic Mail Main Menu of the buyer" (column 11, lines 25-31).

It would have been obvious to one of ordinary skill in the art at the time the Applicant's

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invention was made to modify the teachings of Popolo to include that the first indication indicating that the response is the best price response, and the second indication indicating that the response is not the best price response since Popolo's system automatically notifies the buyer of the acceptance or rejection by electronic mail which appears as new mail to the buyer. One of ordinary skill in the art would have been motivated to do so because, it greatly improves the efficiency of the system by providing the user with detailed information, and a system that is user friendly.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popolo, U.S. patent 5,715,402 in view of Kalmus et al, U.S. patent 4,674,044.

Claim 10, Popolo does not disclose a group including a stock, a bond, a treasury bill, or a derivative.

Kalmus et al disclose a method for trading a stock, via a communication network to determine a best price therefor and provide indications to winners and losers (e.g., Figures 1-5; column 1, line 6 et seq; column 4, line 22 et seq). A trading method that yields a best price for a stock provides an improved, more efficient market (e.g., column 2, line 1 et seq; column 5, line 5 et seq).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the trading of Popolo to determine a best price for stocks, as taught by Kalmus et al to promote market efficiency.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



HANI M. KAZIMI
PRIMARY EXAMINER
Art Unit 3624

January 10, 2002